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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,377	03/27/2001	Daniel F. Williams	PSTM0041/MRK	5661

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EXAMINER

WEBB, JAMISUE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,377

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisue A. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 8, 9 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10-14 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 1/18/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims have added the following limitations which are not supported by the original specification “the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels” the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being “restricted from finalizing the shipping labels”, and the phrase “partial shipment information” does not appear in the specification, therefore the applicant not having support for this phrase in the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 7, 11, 13 and 14 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above “objection to amendment” for reasoning.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 7 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Stefik et al. (US 2003/0115144).

6. With respect to Claims 7 and 10-14: Stefik discloses the use of a computer system that is programmed to:

a. In response to a request by a first user to generate a digital work (See Figure 1), The examiner considers the system of Stefik to be fully capable of generating a printable bar-coded pre-processing traveler label, in response to a ship request due to the fact that this is considered to be intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30F. 3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). Therefore due to the fact, that Stefik discloses the computer system assigning rights of access to digital works (see paragraphs 0016, 0040, 0065-0067), the computer system of Stefik is fully capable of designating a first user in a memory accessible by the computer system as restricted from finalizing shipping labels, and

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wherein the printable bar-coded pre-processing traveler label contains partial shipment information;

b. The examiner considers the computer system of Stefik to be fully capable of delegating finalizing a shipping label for shipping the parcel to a second user within the enterprise, wherein the second user is designated in the memory accessible of the computer system as authorized to finalize shipping labels (see reasoning above for intended use of the computer system).

7. With respect to Claim 10: Stefik discloses a computer system which is programmed to:

c. According to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). The examiner considers the system of Stefik to be fully capable of being used with shipping labels and shipping requests due to the fact that this is considered to be intended use. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987), *In re Paulsen*, 30F. 3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994). Therefore due to the fact, that Stefik discloses the computer system assigning rights of access to digital works (see paragraphs 0016, 0040, 0065-0067), the computer system of Stefik is fully capable of designating a first user in a memory accessible by the computer system as restricted from printing by authorized to submit a request.

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- d. The examiner considers the computer system of Stefik to be fully capable of according to a second set of instructions input by the administrator, designating in the memory, a second shipping privilege setting identifying a second user within the enterprise as authorized to print shipping labels. (see reasoning above for intended use of the computer system)
8. With respect to Claim 11: The examiner considers the computer system of Stefik to be fully capable of recognizing as a pre-processing shipping request to generate a printable bar-coded pre-processing traveler label containing partial shipment information, a request input by the first user to ship a particular package. (see reasoning above for intended use of the computer system).
9. With respect to Claim 12: The examiner considers the computer system of Stefik to be fully capable of assigning a tracking number and storing it in memory. (See reasoning above for intended use of the computer system).
10. With respect to Claim 13: The examiner considers the computer system of Stefik to be fully capable of generating a printable bar-coded pre-processing traveler label containing partial shipment information in response to a shipping request by the first user. (See reasoning above for intended use of the computer system).
11. With respect to Claim 14: The examiner considers the computer system of Stefik to be fully capable of generating a printable bar-coded pre-processing traveler label in response to a shipping request by the first user wherein the printable bar-coded pre-processing traveler label comprises a bar-coded expression of the internal system tracking number and wherein the printable bar-coded pre-processing traveler label comprises a machine-readable expression of

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partial shipment information. (See reasoning above for intended use of the computer system for use in the shipping label).

12. With respect to Claim 23: The examiner considers the computer system of Stefik to be fully capable of generating for the printable bar-coded pre-processing traveler label a machine-readable code, saving in a memory accessible by the computer system, an association between the machine-readable code and the request by the first user to ship the parcel, and printing a traveler label. (See reasoning above for intended use of the computer system). The system of Stefik creates digital works and prints them out, therefore the fact that the digital work is a traveler label or barcode is deemed to be intended use of the system.

13. With respect to Claim 24: The examiner considers the computer system of Stefik fully capable of recognizing as a completion request for the completion of the request by the first user to ship the parcel, a scan by the second user of the expression of the machine-readable code from the traveler label. (See reasoning above for intended use of the computer system for use to create a shipping label).

14. With respect to Claim 25: The examiner considers the computer system of Stefik fully capable of completing the request by the first user to ship the parcel with information input by the second user. (See reasoning above for intended use of the computer system for use to create a shipping label).

15. With respect to Claim 26: The phrase “wherein the printable bar-coded pre-processing traveler label comprises a representation of a machine-readable expression of a system tracking number for tracking the parcel within the enterprise” is considered to be nonfunctional descriptive material and is not functionally involved in the steps recited. The generation step of

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the car coded label would be performed the same regardless of what type of information is coded within the barcode. Thus this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F .2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F .3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Response to Arguments

16. Applicant's arguments with respect to claims 7 and 10-14 have been considered but are moot in view of the new ground(s) of rejection.

Prior Art

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kimura (6,829,059) discloses the use of a printing system with access rights, Patton et al. (6,842,533) discloses the use of a printing images, and Brogliatti et al. (6,564,225) discloses the use of a computer system with levels of access.

Conclusion

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jamisue Webb

